



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,126	04/09/2001	Nicholas Bennett	3182/FBR	7244

7590 10/29/2003  
Rosenman & Colin LLP  
575 Madison Avenue  
New York, NY 10022-2585

EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
----------	--------------

3714

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/829,126

Applicant(s)

BENNETT, NICHOLAS

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☒ Claim(s) 8 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 & 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. (US Patent Number 6,142,873) in view of Helm et al. (US Patent Number 4,743,024)

**Claim 1:** Weiss teaches a gaming machine (Fig 1) having a display means (6) and a game control means (64) arranged to control images displayed on the display. The game control means being arranged to play a game wherein one or more random events are caused to be displayed on the display means (i.e., the reels spin) and, if a predefined winning event results, the machine awards a prize. (Fig 2) The gaming machine includes a feature of a changing representation of the awarding of the prize (20) and a player-operable control device (12), which, upon manipulation by a player, controls an outcome of the representation to determine an amount, awarded to the player. (Fig 2) Weiss fails to teach that the prize is dependent on when the player operates the control device. Helm teaches a slot machine with a skill stop feature that gives the player control over what indicia are displayed when the player operates a control device (26 or 28). (Col 5, 30-42) This means the prize is dependent on when during the changing of the representation

Art Unit: 3714

(i.e., of the reels) the player operates the control device. These reels are analogous to Weiss's reel (18) that is part of the claimed feature. Skill stop games are well known to the art and give the player a feeling of control, plus they are more challenging than simple slot machines. This increases player enjoyment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the prize be dependent on when the player operates the control device during the changing of the representation in order to give the player a feeling of control and present a greater challenge than offered by simple slot machines, thus increasing player enjoyment.

**Claim 2:** Weiss, Fig 1, 11 is a representation of a win meter.

**Claim 3:** Weiss, Fig 1, 11 is a graphical display representing a changing award.

**Claim 4:** The amount represented by Weiss's graphical display (11), where it is stopped by the player, is awarded to the player as the prize. (Col 2, 1-6)

**Claim 15:** Weiss's control device is an actuator (50) operable by the player to stop changes in the representation. (Col 3, 46-51)

**Claim 16:** Weiss teaches the feature is triggered upon the occurrence of a trigger condition arising in a base game. (Abstract)

**Claim 17:** Helm teaches a tournament being played among a group of linked gaming machines. (Col 6, 1-8)

3. Claims 5-7, 9-12 & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss and Helm as applied to claim 4 in view of Huard et al. (US Patent Number 5,743,800).

**Claim 5:** Weiss and Helm teach the invention substantially as claimed. Weiss discloses a threshold value such that when that threshold value is reached by the graphical display

without having being stopped by the player, a losing outcome results. (Fig 2, Col 1, 62 – Col 2, 17) Weiss does not, however, specifically state that the game controller selects the threshold value. Huard teaches the game controller randomly selecting the bonus amount. (Abstract) The bonus amount is equivalent to the threshold – it represents the maximum bonus amount available. Randomly determining the bonus amount (threshold) increases the excitement of the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the game controller select the threshold in order to increase the excitement of the game.

**Claims 6, 11:** Weiss teaches that when the graphical display (11) commences changing (i.e., the bonus accumulates), the player is able to stop the graphical display at any time by means of the control device – the quit/retire button (50). The arrangement is such that, if the graphical display reaches the threshold value, the losing outcome results but, if the player operates the control device (i.e., retires) before the threshold value is reached, the player may be awarded the amount represented by the graphical display at the time that the control device is operated. (Fig 2, Col 1, 62 – Col 2, 17)

**Claims 7, 12:** The rate at which Weiss' graphical display (11) changes is variable and is set by the game control means. (Col 3, 51-55) In this case, the graphical display (11) changes by adding the variable amount displayed on reel (18). This amount is determined by the control means.

**Claims 9, 14:** Weiss always displays the threshold. Therefore, should the player stop the representation before the threshold value is reached, the game control means causes the

selected threshold value to be displayed so that the player can ascertain when the losing outcome would have resulted.

**Claim 10:** Huard teaches a random number being selected as the threshold value (i.e., maximum prize amount) by the game control means, the random number falling in a predetermined range from one to a highest possible value. (Fig 3)

***Allowable Subject Matter***

4. Claims 8 & 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

5. Applicant's arguments filed 26 September 2003 have been fully considered but they are not persuasive.

6. Applicant argues that Helm's teaching of stopping a reel on a desired number is not applicable to the claimed invention. Clearly this is in error. Weiss teaches a secondary display (20) that contains a representation of a reel. Weiss discloses that this reel is controllable to some extent by the player. This reel has numbers indicating the bonus payout. Clearly, a teaching of stopping a reel on a desired number is applicable to a teaching of a controllable reels with numbers desired by the player. Weiss's reel is a changing representation of the awarding of the prize – the reel spins and the number at which it stops is the prize.

7. Applicant argues that Helm does not teach that the player has a finite amount of time to stop the reel before prejudicing the player's chance to win the prize. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking

Art Unit: 3714

references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is generally known to those of ordinary skill in the art that skill stop games give the player a feeling of control, plus they are more challenging than simple slot machines. This increases player enjoyment – and casino profits.

9. In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977). The difference in the age of the reference is completely immaterial.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Price Is Right Range Game (<http://gscentral.net/range.htm>) shows a moving indicator that is stopped by the player. If the player stops too early, the player loses. If the player stops too late, the player also loses.

Art Unit: 3714


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319.

The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
cbc

  
JESSICA HARRISON  
PRIMARY EXAMINER